The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALEXANDER C. LOUI, KENNETH A. PARULSKI,
THOMAS N. BARARDUCCI, WILLIAM M. JACKSON, and RAJAN L. JOSHI

Appeal No. 2006-0425
Application No. 09/685,998

ON BRIEF

Before BARRETT, BARRY, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-8, which constitute all the claims pending in the application.

We affirm-in-part.

BACKGROUND

The invention relates to a digital camera capable of simultaneously recording both motion and still images. Claim 1 is reproduced below.

> 1. A method for simultaneously recording motion and still images, comprising the steps of:
>
> a) capturing a motion image sequence and accompanying audio of a scene with a digital video camera adapted to record both low resolution motion image sequences and high resolution still images;
>
> b) simultaneously capturing a still image sequence having full resolution images and lower frame rate than the motion image sequence, wherein the full resolution images represent images with more pixels than are represented by the low resolution motion image sequences;
>
> c) compressing the motion image sequence using interframe compression and the accompanying audio and storing the compressed motion image sequences and audio data; and
>
> d) compressing the still images using intraframe coding and storing the compressed still image data.

The examiner relies on the following references:

Brusewitz et al. (Brusewitz)	6,038,257	Mar. 14, 2000 (filed Mar. 12, 1997)
Yamagishi	6,104,752	Aug. 15, 2000 (filed Oct. 1, 1996)
Balakrishnan et al. (Balakrishnan)	US 6,208,691 B1	Mar. 27, 2001 (effective filing date Mar. 28, 1997)

Claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over Brusewitz.

Claims 2-7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Brusewitz and Yamagishi.

Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Brusewitz, Yamagishi, and Balakrishnan.

We refer to the Final Rejection (mailed Oct. 5, 2004) and the Examiner's Answer (mailed Aug. 22, 2005) for a statement of the examiner's position and to the Brief (filed Jun. 16, 2005) for appellants' position with respect to the claims which stand rejected.

OPINION

The examiner submits that Brusewitz teaches all the limitations of instant claim 1, except that the reference fails to disclose capturing audio to accompany the motion image sequence. However, the examiner concludes that the subject matter as a whole would have been obvious, in view of (Official Notice with respect to) the artisan's knowledge and expectation that audio may advantageously accompany image sequences. (Answer at 3-4.)

Appellants argue, however, that Brusewitz fails to disclose or suggest capturing a motion image sequence while simultaneously capturing a still image sequence at a lower frame rate than the motion image sequence. According to appellants, Brusewitz captures only a single high resolution image, responsive to a corresponding still image request from a user, referring to step 54 of Figure 2 of the reference. Appellants submit that, in fact, Brusewitz "actively teaches away" from the instant invention. In appellants'

reading of the reference, if a user wants the camera to capture a second high resolution image, the user must enter another command. Appellants argue that, consequently, Brusewitz does not meet the required capture of a still image sequence simultaneous with, but a lower frame rate than, capture of a motion image sequence. (Brief at 6-7.)

The examiner responds that, as seen in Figure 2 of Brusewitz, the user can enter the command for a still image more than once. When the user enters the command more than once, a sequence of still images will be achieved. As also depicted in Figure 2, according to the examiner, each time a still image is being taken a corresponding low resolution image is also being created. (Answer at 7.)

Appellants further submit that even if a user enters multiple commands in the Brusewitz device to capture multiple high resolution images, there is still no still image sequence captured simultaneously with a motion image sequence as recited in claim 1.

> This is apparent from, for example, the flow diagram in FIG. 2 of Brusewitz, which indicates that receipt of a command to capture a single high resolution image results in an alteration in the manner in which low resolution images are captured. For example, Brusewitz at column 5, lines 54-56, indicates that upon receipt of a command to capture a single high resolution image, "normal video image frame transmission (video mode) operations are suspended." These suspensions may be lengthy, possibly for a period of time encompassing steps 54-66 in the FIG. 2 flow diagram. Accordingly, it is believed that repeated entry of high resolution image capture commands in Brusewitz would not result in the claimed arrangement, in which a still image sequence is captured simultaneously with a motion image sequence.

(Brief at 6.)

We disagree with appellants' assessment of the reference, and consider the examiner's position to be the better founded. As appellants note, Brusewitz teaches that "normal" video mode operations are suspended upon receipt of a request (Fig. 2; box 52) for capture of a high resolution image. However, prior to the section relied upon by appellants, Brusewitz discloses that while the high resolution image is being processed, the production of video image frames may be suspended, but may also be continued at a lower bit rate, such as through interleaving with the high resolution image. Col. 5, ll. 26-41. The "normal" video mode, on the other hand, typically comprises a 30 frame per second sequence at a usual video resolution. Col. 5, ll. 8-11. Brusewitz expressly teaches that the capture of the last video frame (box 68) and high resolution image (box 54) should occur substantially simultaneously. Col. 6, l. 66 - col. 7, l. 1. Instant claim 1 does not distinguish over capture of video image frames that may differ in bit rate; i.e., differing between a normal bit rate and one that is lower than the normal.

Further, we do not consider the reference's showing of capturing a "single" high resolution image (e.g., Fig. 2) to constitute a "teaching away" from the invention. "A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1090, 37 USPQ2d 1237, 1241 (Fed. Cir. 1995) (quoting In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131

(Fed. Cir. 1994)). We find no warning to the artisan in the reference against requesting more than one high resolution image while capturing a video sequence.

The examiner's position, in essence, rests on the finding that the artisan would have appreciated that, with normal use of the Brusewitz device, a still image sequence would be simultaneously captured along with a motion image sequence, within the meaning of instant claim 1. As appellants have not persuaded us of error in the position, we sustain the rejection of claim 1 under 35 U.S.C. § 103.

Instant claim 2 recites, inter alia, "means for automatically providing a repeating sequence of full resolution image frames regularly interspersed between reduced resolution image frames. . . ." According to appellants, corresponding structure is found in the specification at Figure 3 (switch 64, processors 66, 68 of digital motion/still camera 12) and page 8, line 18 through page 9, line 14 of the written description. (Brief at 3.)

We agree with appellants, for the reasons expressed in the Brief, that the rejection fails to show disclosure or suggestion of the above-noted means of claim 2. Even assuming that Brusewitz teaches that each high resolution image "is automatically regularly interspersed between reduced resolution images," as alleged at page 8 of the Answer, we find no structure in the reference that performs the function of automatically providing a repeating sequence of full resolution image frames, as claimed. Further, the rejection fails to show suggestion for such structure in the applied prior art.

The Yamagishi and Balakrishnan references as applied do not remedy the basic deficiency in the rejection relating to what Brusewitz is purported to teach or suggest. We therefore do not sustain the rejection of claim 2, nor of claims 3 through 8 depending therefrom.

CONCLUSION

The rejection of claims 1-8 under 35 U.S.C. § 103 is affirmed with respect to claim 1, but reversed with respect to claims 2-8. The examiner's decision is thus affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a). See 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

LEE E. BARRETT
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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